

ESTTA Tracking number: **ESTTA151716**

Filing date: **07/18/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	Toyota Jidosha Kabushiki Kaisha, t/a Toyota Motor Corporation
Granted to Date of previous extension	07/25/2007
Address	1, Toyota-cho Toyota Aichi, 471 JAPAN

Name	Toyota Motor Sales, U.S.A., Inc.
Granted to Date of previous extension	07/25/2007
Address	19001 South Western Avenue Torrance, CA 90509 UNITED STATES

Attorney information	Alan S. Cooper Howrey LLP 2941 Fairview Park Drive Suites 200 & 300 Falls Church, VA 22042 UNITED STATES coopera@howrey.com, keya@howrey.com, mckeons@howrey.com, ipdocketing@howrey.com Phone:202.783.0800
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Applicant Information

Application No	79023675	Publication date	03/27/2007
Opposition Filing Date	07/18/2007	Opposition Period Ends	07/25/2007
International Registration No.	0884007	International Registration Date	02/12/2006
Applicant	EXIMAS Maschinen-Export-Import GmbH Europastr. 20 Aßlar 35614 GERMANY		

Goods/Services Affected by Opposition

Class 033.

All goods and sevicees in the class are opposed, namely: Alcoholic beverages, namely, distilled spirits, vodka and liqueurs manufactured in Kazakhstan and Russia

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1574718	Application Date	08/05/1987
Registration Date	01/02/1990	Foreign Priority Date	02/17/1987
Word Mark	LEXUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: AUTOMOBILES		

U.S. Registration No.	1675339	Application Date	10/26/1990
Registration Date	02/11/1992	Foreign Priority Date	NONE
Word Mark	LEXUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 037. First use: First Use: 1989/08/02 First Use In Commerce: 1989/08/02 repair and maintenance services for automotive vehicles Class 039. First use: First Use: 1989/08/02 First Use In Commerce: 1989/08/02 automotive vehicle leasing services		

U.S. Registration No.	1739201	Application Date	01/29/1991
Registration Date	12/08/1992	Foreign Priority Date	NONE
Word Mark	LEXUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1991/08/04 First Use In Commerce: 1991/08/04 financing the purchasing and leasing of automobiles		

U.S. Registration No.	1814753	Application Date	09/29/1992
Registration Date	01/04/1994	Foreign Priority Date	NONE
Word Mark	LEXUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1989/09/01 First Use In Commerce: 1989/09/01 cellular telephones		

U.S. Registration No.	1834147	Application Date	10/01/1990
Registration Date	05/03/1994	Foreign Priority Date	NONE
Word Mark	LEXUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 006. First use: First Use: 1989/11/01 First Use In Commerce: 1989/11/01 key rings</p> <p>Class 009. First use: First Use: 1989/11/01 First Use In Commerce: 1989/11/01 [sunglasses, automatic units for storing and dialing phone numbers, binoculars, and] compact disc holders</p> <p>Class 014. First use: First Use: 1989/11/01 First Use In Commerce: 1989/11/01 clocks[and world time clocks]</p> <p>Class 016. First use: First Use: 1989/11/01 First Use In Commerce: 1989/11/01 ballpoint pens</p> <p>Class 018. First use: First Use: 1989/11/01 First Use In Commerce: 1989/11/01 umbrellas [and attache case]</p> <p>Class 020. First use: First Use: 1989/11/01 First Use In Commerce: 1989/11/01 [non-metal key rings and key chains]</p> <p>Class 021. First use: First Use: 1989/11/01 First Use In Commerce: 1989/11/01 drinking cups</p> <p>Class 025. First use: First Use: 1989/11/01 First Use In Commerce: 1989/11/01 jackets, sweat shirts, caps, sweaters, polo shirts, sport shirts, pullovers, windbreakers,[visors,] golf shirts,[and crewnecks]</p> <p>Class 028. First use: First Use: 1990/08/01 First Use In Commerce: 1990/08/01 golf balls, golf bags, [golf bag travel covers, head covers for golf clubs, and golf ball spotters]</p>		

U.S. Registration No.	1806580	Application Date	02/18/1993
Registration Date	11/23/1993	Foreign Priority Date	NONE
Word Mark	L LEXUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1992/07/15 First Use In Commerce: 1992/07/15 retail sales of previously owned automobiles		

U.S. Registration No.	1871549	Application Date	07/02/1993
Registration Date	01/03/1995	Foreign Priority Date	NONE
Word Mark	LEXUS EXTRA CARE		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 036. First use: First Use: 1989/10/00 First Use In Commerce: 1989/10/00 administration of financial and insurance service agreements providing for repairs of automotive vehicles, towing, gas delivery, and flat tire service for disabled vehicles; reimbursement for substitute transportation, lodging, and meals; and motor vehicle insurance underwriting

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Signature	/Alan S. Cooper/
Name	Alan S. Cooper
Date	07/18/2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application:

Serial No.: 79/023,675
Filed: February 12, 2006
Applicant: EXIMAS Maschinen-Export-Import GmbH Ltd.
Mark: VODKA LEXUS & Design
For: Alcoholic beverages, namely, distilled spirits, vodka and liqueurs
manufactured in Kazakhstan and Russia
Class: 33

Published in the Official Gazette of March 27, 2007

TOYOTA JIDOSHA KABUSHIKI KAISHA
ALSO DOING BUSINESS AS TOYOTA
MOTOR CORPORATION

and

TOYOTA MOTOR SALES, U.S.A., INC.

Opposers

v.

EXIMAS MASCHINEN-EXPORT-IMPORT
GMBH LTD.

Applicant

Opposition No. _____

NOTICE OF OPPOSITION

Toyota Jidosha Kabushiki Kaisha, also doing business as Toyota Motor Corporation, a Japanese corporation having its principal offices at 1 Toyota-Cho, Toyota, Aichi 471, Japan ("TMC"), and Toyota Motor Sales, U.S.A., Inc., a California corporation having its principal offices at 19001 South Western Avenue, Torrance, California 90509 ("TMS"), believe that they will be damaged by registration of the mark shown in Application Serial No. 79/023,675 and hereby oppose same.

The grounds for the opposition are as follows:

(1) Application Serial No. 79/023,675 (the "opposed application") seeks to register the mark VODKA LEXUS & Design ("VODKA LEXUS") for alcoholic beverages, namely, distilled spirits, vodka and liqueurs manufactured in Kazakhstan and Russian.

(2) The opposed application was filed based on Applicant's request for extension of protection of International Registration No. 884,007 which issued February 12, 2006.

(3) On information and belief, Applicant has not made any use of the trademark VODKA LEXUS in interstate commerce and/or in commerce between the United States of America and any foreign country.

(4) Long prior to the February 12, 2006 issue date of the international registration of the mark VODKA LEXUS stated in the opposed application, Opposers adopted, used and are still using the trade name LEXUS and the trademarks and service marks LEXUS and LEXUS & Design (collectively "LEXUS") in interstate commerce for automobiles, repair and maintenance services for automotive vehicles and automotive vehicle leasing services, financing the purchasing and leasing of automobiles, conducting product demonstrations that offer participants the opportunity to drive automotive vehicles from different manufacturers, serving food and beverages at demonstrations of automotive vehicles, retail sales of previously owned automobiles, and a variety of automotive products and accessories.

(5) Opposer TMC is the owner of the trade name, trademark and service mark LEXUS. Opposer TMS is a wholly-owned subsidiary of TMC and is the exclusive importer and distributor of LEXUS automobiles throughout the United States except the State of Hawaii.

(6) Opposers are related companies within the meaning of § 5 of the Federal Trademark Act, 15 U.S.C. § 1055. Consequently, all use of the trade name, trademark

and service mark LEXUS by Opposer TMS inures to the benefit of Opposer TMC.

(7) Opposers have continuously used the trade name and mark LEXUS for automobiles and structural parts and accessories therefore, and related automotive services, and in the advertising and sale thereof, in interstate commerce since long prior to the date of the international registration on which Application Serial No. 79/023,675 of the mark VODKA LEXUS is based.

(8) By virtue of the prior, continuous and substantial advertising and sales of automobiles and structural parts and accessories therefor and related automotive services under the trade name and mark LEXUS, the maintenance of premium quality standards relating thereto, purchasers of such services and goods as well as the general public have come to recognize the name and mark LEXUS as an distinctive, singular indication of origin in Opposers, as a consequence of which Opposers have established valuable goodwill and exclusive rights in this trade name and mark.

(9) The mark LEXUS had become exceedingly well-known mark having a particular and singular meaning among the general consuming public and thus had become a famous mark within the meaning of § 43(c)(2)(A) of the Federal Trademark Act, as amended, long prior to the date of the international registration on which Applicant's application is based.

(10) Opposer TMC duly registered LEXUS as a trademark for automobiles in the United States Patent and Trademark Office under Registration No. 1,574,718 which issued January 2, 1990.

(11) Opposer TMC duly registered LEXUS as a service mark for repair and maintenance services for automotive vehicles and automotive vehicle leasing services in the United States Patent and Trademark Office under Registration No. 1,675,339 which issued February 11, 1992.

(12) Opposer TMC duly registered LEXUS as a service mark for financing the purchasing and leasing of automobiles in the United States Patent and Trademark Office under Registration No. 1,739,201 which issued December 8, 1992.

(13) Opposer TMC duly registered LEXUS & Design as a trademark for cellular telephones in the United States Patent and Trademark Office under Registration No. 1,814,753 which issued January 4, 1994.

(14) Opposer TMC duly registered LEXUS & Design as a trademark for key rings; sunglasses, automatic units for storing and dialing phone numbers, binoculars, and compact disc holders; clocks and world time clocks; ballpoint pens; umbrellas and attaché cases; non-metal key rings and key chains; drinking cups; jackets, sweat shirts, caps, sweaters, polo shirts, sport shirts, pullovers, windbreakers, visors, golf shirts, and crewnecks; and, golf balls, golf bags, golf bag travel covers, head covers for golf clubs, and golf ball spotters in the United States Patent and Trademark Office under Registration No. 1,834,147 which issued May 3, 1994.

(15) Opposer TMC duly registered LEXUS EXTRA CARE as a service mark for administration of financial and insurance service agreements providing for repairs of automotive vehicles, towing, gas delivery, and flat tire service for disable vehicles; reimbursement for substitute transportation, lodging and meals; and motor vehicle insurance underwriting under Registration No. 1,871,549 which issued January 3, 1995.

(16) Registration Nos. 1,574,718, 1,675,339, 1,739,201, 1,806,580, 1,814,753, 1,834,147 and 1,871,549 are prima facie evidence of the validity and exclusive right to use the mark LEXUS and are constructive notice of ownership thereof, all as provided by §§ 7(b) and 22 of the Federal Trademark Act, 15 U.S.C. §§ 1057(b) and 1072. As the right to use the mark LEXUS has become incontestable, Registration Nos. 1,574,718, 1,675,339, 1,739,201, 1,806,580, 1,814,753, 1,834,147 and 1,871,549 are conclusive evidence of the exclusive right to use the mark shown therein in commerce

as provided by §§ 15 and 33(b) of the Federal Trademark Act, 15 U.S.C. §§ 1065 and 1115(b).

(17) The use of the trademark VODKA LEXUS in connection with the alcoholic beverages described in the opposed application is likely to dilute the distinctive qualities of the famous mark LEXUS within the meaning of §§ 13(a) and 43(c) of the Federal Trademark Act thereby damaging Opposers.

(18) The services and goods described in Registration Nos. 1,574,718, 1,675,339, 1,739,201, 1,806,580, 1,814,753, 1,834,147 and 1,871,549 and otherwise sold and/or rendered by Opposers under the mark LEXUS, including the serving of food and beverages at demonstrations of automotive vehicles, and the alcoholic beverages described in the opposed application are likely to be sold through commercially related channels of trade to the same or overlapping classes of purchasers. Accordingly, purchasers, prospective purchasers and others are likely to be confused, mistaken or deceived into the belief, contrary to fact, that the alcoholic beverages sold under the mark VODKA LEXUS emanate from and/or are in some way sponsored or approved by Opposers and/or that Applicant is somehow affiliated with Opposers, thereby damaging Opposers.


(19) Applicant is not lawfully entitled to the registration which it seeks for the reason, *inter alia*, that Applicant's mark VODKA LEXUS, as used in connection with goods described in the opposed application, so resembles Opposers' previously used and registered mark LEXUS as to be likely to cause confusion, to cause mistake or to deceive within the meaning of § 2(d) of The Federal Trademark Act, thereby damaging Opposers.

WHEREFORE, Opposers believe that the present opposition should be sustained and the registration of Applicant's mark refused.

The Commissioner for Trademarks is authorized to deduct the necessary fees from Howrey LLP Deposit Account No. 08-3038.

TOYOTA JIDOSHA KABUSHIKI KAISHA
ALSO DOING BUSINESS AS TOYOTA
MOTOR CORPORATION and TOYOTA
MOTOR SALES U.S.A., INC.

Dated: July 18, 2007

By: 

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